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OFFICE OF PETITIONS

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In re Application of :
Sherer, et al. : **DECISION ON PETITION**
Application No. 09/488,942 :
Filed: 20 January, 2000 :
Attorney Docket No. 1112-US-CIP :

This is in response to the petition filed inappropriately under 37 C.F.R. §1.47(b) on 18 September, 2000, and properly considered under 37 C.F.R. §1.47(a).

The petition as considered under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

A grantable petition under 37 CFR 1.47(a) requires: (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

From the outset, as indicated above Petitioner filed the instant petition under an inappropriate provision of the rule (i.e., filed under 37 C.F.R. §1.47(b), rather than under 37 C.F.R. §1.47(a))—and in doing so appears (without explanation as to rationale or statement of authority) to have

signed the oath/declaration on behalf of several non-signing inventors when there appear to have been at least three signing inventors who undertook that duty..

More problematic, however, are that:

- the petition (in its several iterations) is unsigned;
- Petitioner appears to represent that there is only one non-signing inventor when it appears that there are at least four (4) non-signing inventors;
- there is no documentation that supports the averment that a copy of the entire application (description, claims, abstract, drawings) was sent to any of the non-signing inventors as required;
- there is no statement of address for at least three of the four non-signing inventors and there is no showing whatsoever of diligent effort on the part of Petitioner to ascertain reasonably believed to be current/valid/last known addresses for any of the four non-signing inventors.

Moreover, Petitioner does not seemed to have worked through the requirements of the petition, as set forth above, in satisfaction of those requirements.

Thus, Petitioner Applicant also lacks: demonstration that the non-signing inventors cannot be reached or refuse to sign the oath or declaration after having been presented with the entire application (description, claims, abstract and drawings), as set forth above. (Again, as to proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings): the applicable statute (35 U.S.C. § 116) requires that a “diligent effort” have been expended in attempting to find or reach the non-signing inventor. *See* MPEP §409.03, and §409.03(a) and (e): “a *bona fide* attempt.”)

The matters must be clarified on any renewed petition.

BACKGROUND

The record indicates:

The instant application was filed on 21 January, 2000, without, inter alia, a fully executed oath/declaration.

On 24 March, 2000, the Office mailed a Notice of Missing Parts indicating, inter alia, that a fully executed oath/declaration (signed and dated) was required.

On 18 September, 2000, Petitioner (former Counsel) John P. Wagner, Jr. (Reg. No. 35,398) filed the instant petition with, *inter alia*, an oath/declaration signed by Messrs. Sherer, Connery and Reid on behalf of themselves and the non-signing inventors Niles E. Strohl (Mr. Strohl), Richard Hausman (Mr. Hausman), James P. Rivers (Mr. Rivers) and Cynthia Zikmund (Ms. Zikmund), and no evidence of:

- the presentation (or not) of the entire application to the non-signing inventors;
- as to whether the non-signing inventors had or had not been found; and
- as to the issues of the diligent effort used (or not) to ascertain a reasonably believed to be current/valid/last known address for the non-signing inventors, followed by transmittal of the entire application to them and then their subsequent failure/refusal to sign/join in the declaration.

Also, there appears to be new Counsel of Record.

As set forth above, any renewed petition by new Counsel must clarify and resolve these items.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

CONCLUSION

The instant petition under 37 C.F.R. §1.47(a) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

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Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2²) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.